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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,932	04/11/2000	David Wilkins	DIGIP008	4441

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EXAMINER	
POKRZYWA, JOSEPH R	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/546,932	WILKINS ET AL.	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *20-35* is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/8/04, and has been entered and made of record. Currently, **claims 1-35** are pending.

Specification

2. The objection to the specification, as cited in the Office action dated 11/3/03, is withdrawn, as it is overcome by the changes set forth in the amendment dated 10/8/04.

Claim Objections

3. The objection to **claims 20 and 28**, as cited in the Office action dated 11/3/03, is withdrawn, as it is overcome by the changes set forth in the amendment dated 10/8/04.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-13, 17, and 18** are rejected under 35 U.S.C. 102(e) as being anticipated by McCarthy *et al.* (U.S. Patent Number 6,335,983, cited in the Office action dated 11/3/03 as Pertinent Prior Art).

Regarding ***claim 1***, McCarthy discloses a method of modifying a first multimedia asset to form a second multimedia asset (see Figs. 2 and 3) comprising applying a multimedia asset processing command (color adjustment function 22) to the first multimedia asset to form the second multimedia asset (see Fig. 2, column 7, lines 10-46), wherein the first multimedia asset is stored in a file excluding the second multimedia asset and the multimedia asset processing command is associated with the second multimedia asset (column 6, line 64-column 7, line 9, and column 9, lines 4-13), and uniquely linking the second multimedia asset to the first multimedia asset file using the multimedia asset processing command such that the first multimedia asset is utilized to produce the second multimedia asset (see Figs. 2 and 3, column 6, line 64-column 7, line 9, and column 7, line 47-column 8, line 45).

Regarding ***claim 2***, McCarthy discloses the method discussed above in claim 1, and further teaches that the applying comprises determining if the second multimedia asset is associated with an edit list that includes the multimedia asset processing command (column 9, line 54-coumn 9, line 13), retrieving the edit list (column 8, line 31-column 9, line 3), processing the first multimedia asset using the multimedia asset processing command included in the edit list (column 6, line 64-column 7, line 9, and column 7, line 47-column 8, line 45), and outputting the processed first multimedia asset in the form of the second multimedia asset (column 6, line 64-column 7, line 9, and column 7, line 47-column 8, line 45).

Regarding ***claim 3***, McCarthy discloses the method discussed above in claim 2, and further teaches that the linking comprises associating an edit list pointer with the second multimedia asset that points back to the edit list (column 6, line 64-column 7, line 9, and column 7, line 47-column 8, line 45).

Regarding ***claim 4***, McCarthy discloses the method discussed above in claim 2, and further teaches that the linking comprises embedding the edit list in the second multimedia asset (column 6, line 64-column 7, line 9, and column 7, line 47-column 8, line 53).

Regarding ***claim 5***, McCarthy discloses the method discussed above in claim 2, and further teaches that when the first multimedia asset does not have an associated edit list, or the associated edit list is empty (see Fig. 2), then the first multimedia asset is a reference multimedia asset (digital negative, column 5, lines 7-21).

Regarding ***claim 6***, McCarthy discloses the method discussed above in claim 2, and further teaches that the applying is performed by a processor arranged to perform executable instructions (column 9, lines 14-24).

Regarding ***claim 7***, McCarthy discloses the method discussed above in claim 6, and further teaches that the first multimedia asset and the second multimedia asset are a first digital image and a second digital image, respectively (column 5, line 7-column 7, line 30).

Regarding ***claim 8***, McCarthy discloses the method discussed above in claim 7, and further teaches that the multimedia processing command provides the processor with appropriate digital image processing instructions (column 7, line 10-column 8, line 30).

Regarding ***claim 9***, McCarthy discloses the method discussed above in claim 7, and further teaches that the processor is included in a host computer coupled to a distributed network of computers (column 4, line 9-column 5, line 6, and column 7, line 47-column 8, line 30).

Regarding ***claim 10***, McCarthy discloses the method discussed above in claim 2, and further teaches that the second multimedia asset includes a watermark that includes the edit list (column 7, line 10-column 8, line 30, and column 9, lines 4-25).

Regarding ***claim 11***, McCarthy discloses the method discussed above in claim 9, and further teaches that the first digital image is stored in an image database included in a client computer coupled to the host computer (column 7, line 10-column 8, line 30).

Regarding ***claim 12***, McCarthy discloses the method discussed above in claim 9, and further teaches that the linking comprises associating an edit list pointer with the second multimedia asset that points back to the edit list, wherein the pointed to edit list is stored in an edit list database included in the host computer (column 7, line 10-column 8, line 30).

Regarding ***claim 13***, McCarthy discloses the method discussed above in claim 12, and further teaches that the first digital image is forwarded to the host computer wherein the processor processes the first digital image based upon processing instructions included in the pointed to edit list to form the second digital image (column 6, line 64-column 7, line 9, column 7, line 47-column 8, line 53, and column 9, lines 4-25).

Regarding ***claim 17***, McCarthy discloses the method discussed above in claim 7, and further teaches that the first digital image and the second digital image are each a first still digital image and a second still digital image, respectively (column 4, line 9-column 5, line 21, and column 7, line 47-column 8, line 30).

Regarding ***claim 18***, McCarthy discloses the method discussed above in claim 17, and further teaches that the first still digital image is one of a first plurality of digital video images that taken together form a first video and wherein the second still digital image is one of a second plurality of digital video images that taken together form a second video (column 4, line 9-column 5, line 21, and column 7, line 47-column 8, line 30).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy *et al.* (U.S. Patent Number 6,335,993, cited in the Office action dated 11/3/03 as Pertinent Prior Art) in view of Parulski *et al.* (U.S. Patent Number 6,567,119, cited in the Office action dated 11/3/03).

Regarding ***claim 14***, McCarthy discloses the method discussed above in claim 9, but fails to expressly disclose if the host computer further includes a decimator unit to produce a low-resolution thumbnail image of the second digital image.

Parulski discloses a method having a first digital image is stored in an image database included in a client computer (remote computer 72) coupled to the host computer (see Fig. 3, whereby the thumbnail image data 98 is included in the FlashPix file transmitted over transmission link 70 to the remote computer 72). Further, Parulski teaches that the host computer

includes a decimator unit to produce a low-resolution thumbnail image of the second digital image (column 5, lines 46 through column 6, line 32, whereby a decimator would inherently be included so as to produce a thumbnail image).

McCarthy & Parulski are combinable because they are from the same field of endeavor, being systems that convert digital photographs based on adjustment functions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Parulski's decimator teachings within the system of McCarthy. The suggestion/motivation for doing so would have been that McCarthy's system would become more efficient, since a low-resolution thumbnail images are stored using less memory, as is widely known throughout the art. Therefore, it would have been obvious to combine the teachings of Parulski with the system of McCarthy to obtain the invention as specified in claim 14.

Regarding ***claim 15***, McCarthy and Parulski disclose the method discussed above in claim 14, and Parulski further teaches that the thumbnail image is forwarded to the client computer (remote computer 72, column 5, lines 38 through 45) and displayed on a display unit coupled thereto (remote output device 74, see Fig. 3).

As discussed above, McCarthy & Parulski are combinable because they are from the same field of endeavor, being systems that convert digital photographs based on adjustment functions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Parulski's decimator teachings within the system of McCarthy. The suggestion/motivation for doing so would have been that McCarthy's system would become more efficient, since a low-resolution thumbnail images are stored using less memory, as is widely known throughout the art. Therefore, it would have been obvious to combine the

teachings of Parulski with the system of McCarthy to obtain the invention as specified in claim 15.

Regarding ***claim 16***, McCarthy and Parulski disclose the method discussed above in claim 15, and Parulski further teaches that the second digital image is forwarded to the client computer based upon the thumbnail image (see Fig. 3, whereby the modified thumbnail image data 23 is included in the FlashPix file transmitted over transmission link 70 to the remote computer 72).

As discussed above, McCarthy & Parulski are combinable because they are from the same field of endeavor, being systems that convert digital photographs based on adjustment functions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Parulski's decimator teachings within the system of McCarthy. The suggestion/motivation for doing so would have been that McCarthy's system would become more efficient, since a low-resolution thumbnail images are stored using less memory, as is widely known throughout the art. Therefore, it would have been obvious to combine the teachings of Parulski with the system of McCarthy to obtain the invention as specified in claim 16.

8. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy *et al.* (U.S. Patent Number 6,335,993, cited in the Office action dated 11/3/03 as Pertinent Prior Art) in view of Barton (U.S. Patent Number 5,912,972, cited in the Office action dated 11/3/03).

Regarding ***claim 19***, McCarthy discloses the method discussed above in claim 1, but fails to expressly disclose if the first multimedia asset is an audio asset and wherein the second multimedia asset includes the audio asset.

Barton discloses a method that modifies a first multimedia asset (column 5, line 64 through column 6, line 12, being a block of digital data) to form a second multimedia asset (being an authenticated digital block), whereby the first multimedia asset is an audio asset and wherein the second multimedia asset includes the audio asset (column 5, line 64 through column 6, line 31, and column 9, lines 18-64, being the MPEG digital movie).

McCarthy & Barton are combinable because they are from the same field of endeavor, being systems that convert digital images based on adjustment functions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Barton's MPEG image data with audio assets within the system of McCarthy. The suggestion/motivation for doing so would have been that McCarthy's system would become operable to more users, since a wider variety of formats would be supported, as recognized by Barton in column 4, line 65-column 5, line 63. Therefore, it would have been obvious to combine the teachings of Barton with the system of McCarthy to obtain the invention as specified in claim 19.

Allowable Subject Matter

9. **Claims 20-35** are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 20**, in the examiner's opinion, it would not have been obvious to have the system, as claimed, include the features of determining whether or not the input digital data

stream includes a digital image processing instruction, and outputting a second digital image, wherein a third digital image is output as the second digital image in response to the presence of the digital image processing instruction within the input digital data stream, and wherein the third digital image is stored in a file excluding the first digital image with the first digital image being linked, via the digital image processing instruction, to the third digital image file to facilitate output of the third digital image, and outputting the digital image processing instruction when the input digital data stream includes the digital image processing instruction.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622

jrp